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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,815

09/25/2003

Paul Moulton

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EXAMINER

NGUYEN, CHI Q

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

08/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,815	<b>Applicant(s)</b> MOULTON ET AL.	
	<b>Examiner</b> Chi Q. Nguyen	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10, 13-15, 17-23, 26-30, 32, 33 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10, 13-15, 17-23, 26-30, 32, 33 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is in response to applicant's amendment filed on 6/18/2007.

Upon further consideration, the previously stated allowable subject matters are withdrawn and with new rejections are followed:

#### ***Status Of Claims***

Claims 2-8, 10, 13-15, 17-23, 26-30, 32-33, and 42-44 are pending and have been examined.

Claims 1, 9, 11-12, 16, 24-25, 31, and 34-41 are cancelled.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 2, 5-8, 33, 10, 19-23, 26-29, 42, and 44 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,637,085 to Hartkorn.

Claims 32-33:

Hartkorn discloses a one-piece compression seal for an expansion joint, consisting of: a compressible sealing portion 2 having elastic membranes 45, 46; and at least one lateral wing 5 extending from the compressible sealing portion, wherein the lateral wing has a thickness that is larger than a thickness of the elastic membranes, and wherein the compressible sealing portion and the lateral wing form structurally integrated parts of a one-piece extruded material (see Fig. 1).

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Claims 2 and 13:

Wherein the thickness of the lateral wing is 3.5cm, which is equivalent to 1.37" or at least a half of an inch.

Claim 5:

Wherein the compressible sealing portion comprises longitudinal tubes 41, 42.

Claim 6.

Wherein the compressible sealing portion comprises a membrane structure having at least one channel 43, wherein the channel allows the compressible sealing portion to vary in lateral width.

Claim 7:

Wherein the lateral wing comprises longitudinal channels (four longitudinal channels on each wing-see Fig. 1).

Claim 8:

Wherein the lateral wing comprises grooved surfaces 40.

Claim 10:

Wherein cross sections of the compression seal along its length have substantially the same structural configuration.

Claim 19.

Wherein the compressible sealing portion comprises longitudinal tubes (see Fig. 1).

Claim 20:

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Wherein the compressible sealing portion comprises a membrane structure having at least one channel 41 or 43, wherein the channel allows the compressible sealing portion to vary in lateral width.

Claim 21:

Wherein the lateral wing comprises longitudinal channels (see Fig. 1-wherein four longitudinal channels on each wing).

Claim 22:

Wherein the lateral wing is hinged at 38 from the compressible sealing portion.

Claim 23:

Wherein cross sections of the compression seal along its length have substantially the same structural configuration.

Claim 26:

Wherein the channel 41 deforms to allow the compressible sealing portion to vary in lateral width.

Claim 27:

Wherein the channel allows the compressible sealing portion to vary in lateral width by deforming vertically with variations in the lateral width of the compressible sealing portion.

Claim 28:

Wherein the channel deforms to allow the compressible sealing portion to vary in lateral width.

Claim 29:

Wherein the channel allows the compressible sealing portion to vary in lateral width by deforming vertically with variations in the lateral width of the compressible sealing portion.

Claim 42:

Wherein the lateral wing is hinged at 38 from the compressible sealing portion.

Claim 44:

Wherein the lateral wing comprises grooved surfaces 40.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 14, 17-18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,637,085 to Harkorn.

Claims 3-4, and 17-18:

Harkorn discloses the basic structures for a joint seal structure as stated above but does not disclose specifically the extruded material comprises ethylene propylene terpolymers, and wherein the extruded material comprises EPDM rubber. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have a specific thickness for a lateral wing to accommodate a joint and a choice of an extruded material for economic reasons.

Furthermore, applicant has not disclosed the criticality of this feature.

Claims 14, 30:

Harkorn discloses the basic structures for a joint seal structure as stated above and further disclose a lateral wing 5 is bonded to a surface 15 by bead 20 but does not disclose specifically the lateral wing is bonded to a surface of an adjacent element by adhesives. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive material to bond two surfaces together for securement purposes.

Claims 15, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,637,085 to Hartkorn in view of US Patent No. 5,584,152 to Baerveldt.

Harkorn discloses the basic structures for the joint seal structure as stated above but does not disclose expressly wherein a surface of the lateral wing is bonded to a surface of an adjacent element by masonry anchoring bolts. Baerveldt discloses a joint seal structure (see Fig. 3), wherein a lateral wing 12 is extending from a seal portion 11 and the lateral wing 12 is bonded to a surface of an adjacent element by masonry anchoring bolt B. In view of Baerveldt, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hartkorn with anchoring bolts in order to secure the joint seal structure in place.

### ***Response to Arguments***

Applicant's arguments with respect to claims 32, 2-8, 26-27, 10, 30, 42-43, 33, 13-25, 17-23, 28-29, and 44 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://paired.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

CGN

8/13/2007

*Basil Katchen*  
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Examiner Art 3635  
8/14/07